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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/605,187

09/12/2003

Eric James Wall

CHM-005M

2186

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7590

08/14/2008

HASSE & NESBITT LLC
8837 CHAPEL SQUARE DRIVE
SUITE C
CINCINNATI, OH 45249

EXAMINER

DESANTO, MATTHEW F

ART UNIT

PAPER NUMBER

3763

MAIL DATE

DELIVERY MODE

08/14/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/605,187	Applicant(s) WALL, ERIC JAMES	
	Examiner MATTHEW F. DESANTO	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7-40, 45 and 47-54 is/are pending in the application.
- 4a) Of the above claim(s) 12, 18, 23-27, 31-35, 37-40, 45, 47 and 48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-11, 13-17, 19-22, 28-30, 36, 49-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Transitional After Final Practice

1. Since this application is eligible for the transitional procedure of 37 CFR 1.129(a), and the fee set forth in 37 CFR 1.17(r) has been timely paid, the finality of the previous Office action is hereby withdrawn pursuant to 37 CFR 1.129(a). Applicant's first submission after final filed on 2/27/08 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5, 7-11, 13-17, 19-22, 28-29, 30, 36, 49-54 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jacobsen et al. (USPN 6, 045, 534) and further in view of Flaherty et al. (USPN 7,303,549) and further in view of Ueda et al. (USPN 7,252,653) and Rise et al. (USPN 5,752,930).

Jacobsen et al. discloses an injection needle (22) that moves from multiple positions during use, a housing (12), a reservoir (18), a means for liquid communication (68+67), a means for inserting the injection needle (58+32), a means for pumping the medicament or urging means (20+16), a means for retracting the injection needle (23) that is on a diagram (18) that is adjusted by the air pressure that is released by the top cover hat interacts with the ball valve. Jacobsen et al. fails to teach the specific size of the needle, the specific flow rate and applying an adhesive to the device's housing.

Flaherty et al. discloses a delivery device with retraction means, injection means, and adhesive means that is an adhesive layer on the outer surface of the housing (Column 21).

Therefore, at the time of the invention it would have been obvious for one of ordinary skill in the art to combine the device of Jacobsen et al. with the teachings of Flaherty because Flaherty discloses the benefit of using an adhesive layer on the housing since it allows for flexing of the skin during attachment and aids in the patients comfort (see Column 21 lines 54-65).

With regards to the other limitations not explicitly recited in the prior art are the flow rate and the size of the needle diameter. Both of these are well known variables that depend on the type of medication, size of the apparatus and form of treatment and are constantly modified depending on medical procedure. Therefore, it would have been obvious to modify the needle and flow rate of the prior art in order to fulfill the claim limitations since all the other limitations are present. Ueda et al. discloses the benefit of having needles with the specific claimed dimensions and Rise et al. discloses varying the flow rate from 1 micro liter per minute to 5000 micro liter per minute. Therefore, these references show how one of ordinary skill in the art would find it obvious to try and modify the prior art reference to the needle and flow rate in order to meet the needs of the infusion rate that is prescribed by the physician and thus fulfilling the claim requirements of applicant's invention.

Response to Arguments

4. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW F. DESANTO whose telephone number is (571)272-4957. The examiner can normally be reached on Monday-Friday 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick LUCCHESI can be reached on (571) 272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Matthew DeSanto
/Matthew F DeSanto/
Primary Examiner, Art Unit 3763